

REMARKS

Claims 1-19 are pending in the instant application. Claims 1, 5, 7, 10, 11, 12 and 14 have been amended and new Claims 20 - 21 are submitted for consideration by the Examiner. Applicants respectfully request reconsideration and allowance of the instant application.

Applicants believe that the above amendments to Claims 1, 5, 7, 10, 11, 12 and 14 overcome the objections and rejections under 35 U.S.C. 112. Applicants respectfully request withdrawal of these objections and rejections.

In response to the obviousness type double patenting rejection based upon U.S. Patent No. 6,753,039, please find attached hereto a Terminal Disclaimer. Please charge any fees associated with the Terminal Disclaimer to Deposit Account No. 15-0680 (Orscheln).

The rejection of Claims 1-2, 4-12, 15-16 and 18-19 under 35 U.S.C. 102(b), as being anticipated by Maurer et al (U.S.P.N. 3,444,007), is respectfully traversed.

Maurer employs a process that includes chromates (i.e., a chromate rinse). In contrast, the rejected claims recite a process that is substantially free of chromates. Maurer, therefore, does not disclose each and every aspect of the claims and cannot anticipate the claimed invention.

The rejection of Claims 1, 3-4, 11-12 and 19 under 35 U.S.C. 102(b) as being anticipated by Hanagata et al. (U.S.P.N. 5,057,335), is respectfully traversed.

Hanagata does not disclose a drying step after being removed from the claimed medium. Hanagata cannot disclose each and every aspect of the claimed invention and, therefore, fails to anticipate the claimed invention.

The rejection of Claims 1-2, 4-7, 11-15 under 35 U.S.C. 102(e) as being anticipated by Heimann et al. (U.S.P.N. 6,592,738), is respectfully traversed.

Please find attached hereto a Declaration under 37 C.F.R. 1.132 that Applicants believe is sufficient to remove USPN '738 as a reference that can be applied against the

instant application. Accordingly, Applicants respectfully request withdrawal of this rejection.

The rejection of Claims 13 and 17 under 35 U.S.C. 103(a) as being unpatentable over Maurer et al., is respectfully traversed.

Maurer et al. have the aforementioned deficiencies. Col. 3, Lines 1-3 of Maurer indicate that there is "...no particular advantage gained from large quantities of the metal ions...". The examples of Maurer use relatively low quantities of metal ions. In light of the teaching that there is no advantage to using large quantities and that lower quantities are actually used, a skilled person in this art would not find it "obvious to try" the claimed amounts. Applicants respectfully submit that Maurer is insufficient to establish a prima facie case of obviousness and, therefore, request withdrawal of this rejection.

The rejection of Claims 5, 8-10, 13, 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Hanagata et al., is respectfully traversed.

Hanagata has the aforementioned deficiencies. With respect to Claim 5, Hanagata does not disclose the claimed process sequence (e.g., contact with medium, drying, rinsing and drying). In regard to Claims 8-10 and 17, as recognized by the Action Hanagata does not disclose the claimed compounds. In the absence of such disclosure, it is just as reasonable to conclude that one of ordinary skilled in the art would pick and choose compounds unrelated to the instant claims. For these reasons, Applicants respectfully submit that Hanagata fails to establish a prima facie case of obviousness against the pending claims.

The rejection of Claims 9-10 and 17 under 35 U.S.C. 103(a) as being unpatentable over Heimann et al., is respectfully traversed.

Applicants respectfully submit that Heimann is commonly owned with the instant application and, therefore, is not available as prior art to reject the instant claims. Accordingly, Applicants request withdrawal of this rejection.

Applicants respectfully request consideration of the references that were of record in the parent application which are included in the references listed on the attached Form PTO-1449. In addition, Applicants respectfully request consideration of commonly assigned U.S. Patent Nos. 6,149,794; 6,258,243; 6,153,080; 6,322,687; 6,572,756; and Application Serial Nos. 09/775,072; 09/814,641; 10/378,983; 09/816,879; 09/755,072; 09/814,641; 10/211,094; and 10/211,051, and the references cited therein.

Applicants believe that the claimed invention defines patentable subject matter and request issuance of a Notice of Allowability. Please find attached hereto a Two Month Extension of Time. Should there be any other fee due in connection with this Response, please charge the same to Deposit Account No. 15-0680 (Orscheln Management Co.). Should the Examiner deem that any further action on the part of Applicant would be desirable, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted,



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Encl.: Two Month Extension of Time
Terminal Disclaimer
1.132 Declaration
Form PTO-1449